



SW 16-16157.9

Excerpt English Translation of Decision W003/02-3.3.2

D (Title Page)

File No. W0003/02-332

DECISION
of the Technical Board of Appeal 3.3.2
Of 31 July 2003

Applicants: Wieland, Heinrich
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Appealed Decision: Protest according to Rule 40.2 c) of the Patent Cooperation
Treat against the Invitation of the European Patent Office
(International Searching Authority) of 23 May 2001 for the
payment of additional Search Fees.

Members of the Board:

Chairman: U. Oswald
Members: M. Ortega Plaza
B. Günzel

[From the section "Facts and Submissions", the middle of page 3 and from the bottom
paragraph to the last paragraph on page 4]

For its reasoning, the IRB (International Search Report) i.a. argued as follows:

*"The use of anti-estrogenic compounds for influencing collagen-containing body parts
is disclosed in Reference (1) EP-A-0-776 661, because Reference (1) describes the use
of anti-estrogenic compounds for treatment of collagen diseases.*

*Furthermore, the use of aromatase inhibitors for influencing some of the diseases
listed in the independent claims is known as well.*

The References (2) WO-A-96 08231 and (3) DE-A-3 338 212 have been cited. Reference (2) describes the use of aromatase inhibitors for decreasing hair growth and Reference (3) describes the use of aromatase inhibitors for treating infarction.

Since the use of aromatase inhibitors and anti-estrogens is disclosed in the prior art for the treatment of some diseases appearing the claims, the claimed uses could not share a single general inventive concept.

Ten (10) groups of inventions have been listed, which relate to the use of either aromatase inhibitors (Groups 1-5), or of anti-estrogens (Groups 6-10) wherein the various aims of treatments are distinguished, namely, for the treatment of heart- and brain infarction and arteriosclerosis (Groups 1 and 6), osteoporosis (Groups 2 and 7), urinary incontinence (Groups 3 and 8), excessive glucocorticoids (Groups 4 and 9) and for the cosmetic treatment of hair and of skin (Groups 5 and 10)."

[From the section "Reasons for the Decision"]

[Page 13, 2nd to 4th paragraph]

3. As already set forth under point II of the facts, the IRB has based the "*a posteriori*" objection of insufficient unity on References (1), (2) and (3) indicated in the search report, because the use of either anti-estrogens or aromatase inhibitors for a treatment of collagen diseases or heart infarction as well as for a treatment of hair growth condition is said to be known from the prior art.

4. The present application deals with further uses of substances, or of compositions containing the same, wherein the substances in claim 1 are defined by means of functional features, namely as "substance which inhibits the production and/or the effects of estrogens". Aromatase inhibitors and anti-estrogens (see claim 2) fall under this definition.

The effect of a substance or the composition is further defined in claim 1 functionally as "for the stabilization, the increase and/or the restoration of collagen".

[Page 15, 5th paragraph]

However, with respect to the use of aromatase inhibitors, it is to be stated that none of the References is able to specifically correlate those with the effect which is defined by function in claim 1.

[Page 17, penultimate paragraph]

With these facts, the Board can follow the IRB only insofar as the present application comprises five (5) groups of inventions, which relate to the further uses of anti-estrogens (Groups 6-10); however, the Board sees one common invention which is formed by the initially listed Groups 1 to 5.

[Page 18, second paragraph]

Order

From these reasons, it is judged:

1. Four additional search fees are to be paid back.
2. Otherwise, the protest is rejected.